

## **REMARKS**

### **I. INTRODUCTION**

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

### **II. STATUS OF THE CLAIMS**

By the present amendment, Claim 1 is cancelled, Claims 3-6 are amended and new Claim 7 is added. That leaves Claims 3-7 pending with Claim 7 being the sole independent claim. It is respectfully submitted that no new matter is added herewith.

### **III. SUMMARY OF THE OFFICE ACTION**

In the Office Action, Claims 1 and 3-6 are rejected under 35 U.S.C. § 112, first and second paragraphs; and Claims 1 and 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi et al.* (U.S. Patent No. 4,633,613) in view of *Bickerstaff* (U.S. Patent No. 4,589,227).

### **IV. REJECTION OF THE CLAIMS**

#### **A. Rejection of Claims 1 and 3-6 under 35 U.S.C. § 112, first paragraph**

Claims 1 and 3-6 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the description. It is Applicant's understanding from the Office Action that the Examiner objects to the specification for inclusion of new matter regarding the term "inflection". In response, Applicant has amended the specification (at paragraph [0002]) to remove the objected to definition of the term "inflection".

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

**B. Rejection of Claims 1 and 3-6 under 35 U.S.C. § 112, second paragraph**

Claims 1 and 3-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, particularly regarding the window trajectory. In response, Applicant has cancelled independent Claim 1 and added new independent Claim 7 to clarify the window trajectory. Note that Claims 3-6 have been amended to change their dependencies from Claim 1 to Claim 7.

Applicant submits that new independent Claim 7 is clear and definite. Consequently, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

**C. Rejection of Claims 1 and 3-6 under 35 U.S.C. § 103(a)**

In the Office Action, Claims 1 and 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi* in view of *Bickerstaff*. Applicant respectfully traverses. Because Claim 1 has been cancelled, Applicant's remarks are made with respect to new independent Claim 7.

Per the Examiner's suggestion in the Office Action, new independent Claim 7 recites "An operating device for a vehicle, *consisting of*", thereby giving the recitation of a "single guide rail" clear patentable weight.

In contrast, the window trajectory of *Kobayashi* is defined by the two rails 54 and 56, not a single rail, as recited in the claimed invention. More specifically, the *Kobayashi* device requires a second guide rail that must be used to provide a pivot in the window pane 18

during its moving. Thus, the *Kobayashi* device cannot achieve its function of moving the window pane 18 using only a single guide rail, as recited in the claimed invention. In the claimed invention, where one single rail is used, a reduction in manufacturing cost and reduction in noise and vibration are obtained.

Moreover, *Bickerstaff* does not cure the deficiencies of *Kobayashi*. *Bickerstaff* is cited only for allegedly teaching an adjusting means. And the means for adjusting the position in the claimed invention is different than in *Bickerstaff*. In the claimed invention, the means for adjusting is the same operating device, such as device 1, and includes two lower transversal screws 9 and 10, whose function is to laterally adjust the position of the whole device to the door of vehicle. Applicant submits that the lateral positioning of the device of the claimed invention as whole is accomplished when the device as a whole is adjusted, including motor, rail and other items, while in *Bickerstaff*, only the lateral position of the glass is accomplished when it moves up and down. Applicant pointed out this distinction in Applicant's previous Amendment; however, the Office Action fails to address it. Indeed, the Office Action fails to address dependent Claim 3 regarding specific features of the means for adjusting and does not provide evidence that such a feature is well known in the art.

Consequently, because *Kobayashi*, either alone or in combination with *Bickerstaff*, fails to teach all of the limitations of the claimed invention, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to new independent Claim 7. Therefore, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

Moreover, dependent Claims 3-6 are allowable for the same reasons as discussed above. Additionally, these claims recite other features not found in *Kobayashi* and

*Bickerstaff*. For example, both *Kobayashi* and *Bickerstaff* fail to teach an upper pivoting axle used on the rail, as in dependent Claim 3. This upper pivoting axle acts as a fixing and allows the rail to tilt slightly to adjust it in the vehicle's door. Such a feature is not found in either *Kobayashi* or in *Bickerstaff*. Again, Applicant raised that distinction in Applicant's previous response; however, the Office Action did not address it.

#### V. CONCLUSION

In view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (001058-00036). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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